REMARKS

The Examiner rejected claims 1-6, 8 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Lauermann, et al., U.S. Patent No. 5,655,613 (Lauermann) in view of Harrigan, et al., U.S. Patent No. 6,371,221 (Harrigan). It is respectfully submitted that all of the claims 1 through 11 are patentable over the prior art.

Specifically, claim 1 recites:

(i) a bit-side, axial stop surface; and

(ii) an end-side outer profile formed as a spline profile and having an outer thread forming radial spline projections of the spline profile.

The foregoing novel features of a tool holder for an annular core bit are not disclosed or suggested in the prior art, including all of the prior art of record in this application.

Considering the prior art, Lauermann discloses a bit holder (1) of which the present invention is an improvement and which has thread means (6) for securing the bit.

Lauermann does not disclose, as it is noted by the Examiner himself, a thread-forming spline profile. The Examiner asserts that replacing the thread profile with a thread-forming spline profile would be obvious in view of Harrigan who discloses a tool shaft with a thread which is formed as a spline profile. Applicant respectfully disagrees with this assertion.

Harrigan discloses a coring bit motor for obtaining material core samples using a coring bit (18). The object of Harrigan is to provide a combination coring motor that would combine two, working together, motors, a spin motor and a thrust motor. To this end, Harrigan provides a coring motor having a spin stator, a spin rotor, and a spin rotor sleeve (23) and a thrust stator, thrust rotor, and a thrust rotor sleeve (33).

The coring motor works together with a coring bit (18) the drive shaft (44) of which has a thread-forming spline profile. The spin rotor sleeve (23) has a spline inner profile corresponding to the spline profile of the drive shaft (44), and the thrust rotor sleeve (33) has a thread inner profile corresponding to the thread profile of the drive shaft, with the spin rotor sleeve and the thrust rotor sleeve being separately driven. Thereby, both rotational and translational movement of the coring bit is insured.

It is noted that the unique design of the drive shaft is provided for use with the uniquely designed coring motor. No other uses of the unique design of the drive shaft are disclosed or suggested.

The present invention is directed to a core bit holder designed for use with both a core bit having a complementary spline profile and a core bit having a complementary thread profile. Harrigan does not disclose a member adapted to be connected, for joint rotation therewith, with another member having either a spline profile or a thread profile and retainable against an axial stop surface.

Applicant respectfully submits that modification of Lauermann in view of Harrigan would be unobvious and could become obvious only in view of the present invention.

The Court of Appeals for the Federal Court clearly stated:

> It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.
>
> *In re Fritch*, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read "into an invention on the basis of Applicant's

own statements", that the prior art must be viewed "without reading into that art Appellant's teachings", an that that teachings of the prior should, "in and of themselves and without the benefits of Appellant's disclosure (emphasis in the original text) make the invention as a whole, obviously." *In re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

It is respectfully submitted that obviousness of the present invention over the combination of Lauermann and Harrigan can be gleaned only from a hindsight reconstruction.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

> When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole

must suggest the desirability, and thus the obviousness, of making the combination.

Nothing in the prior art suggests the desirability of the combination set forth in the Office Action. The same Court further stated:

> . . . it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention."

In view of the above, it is respectfully submitted that the combination of Lauermann and Harrigan does not make obvious the present invention, as defined in claim 1, and the present invention, as defined by claim 1 is patentable over said combination.

Claims 2-11 depend on claim 1 and are allowable as being dependent on an allowable subject matter.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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